

St. Onge Steward Johnston & Reens

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UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
09/077,180	19-Oct-04	KARL STORZ, ET AL.	02931-P0023A

Title: SHAVING OR CUTTING INSTRUMENT

Art Unit	Paper Number
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Correspondence Address:

WESLEY W. WHITMYER JR.
ST. ONGE STEWARD JOHNSTON & REENS LLC
986 BEDFORD STREET
STAMFORD, CT. 06905

PATENT & TRADEMARK OFFICE
MAILED

FEB 10 2005

LICENSING & REVIEW

Please find attached a communication from the Examiner regarding the
Petition for Retroactive License under 37 CFR 5.25.



UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, DC 20231
www.uspto.gov

Wesley W. Whitmyer
ST. ONGE STEWARD JOHNSTON & REENS LLC
986 Bedford Street
Stamford, CT 06905-5619

In re: Storz et al : DECISION ON REQUEST
Serial No.: 09/077,180 : UNDER 37 CFR 5.25
Filing date: July 16, 1998
Docket No: 02931-P0023A

Title: SHAVING OR CUTTING INSTRUMENT

This is a decision on the petition filed on October 19, 2004 for retroactive foreign filing license.

37 CFR 5.25(a) requires the following:

1. A listing of each of the foreign countries in which the unlicensed patent application material was filed,
2. The dates on which the material was filed in each country,
3. A verified statement (oath or declaration) containing:
 - i. An averment that the subject matter in question was not under a secrecy order at the time it was filed abroad, and that it is not currently under a secrecy order,
 - ii. A showing that the license has been diligently sought after discovery of the proscribed foreign filing, and
 - iii. An explanation of why the material was filed abroad through error and without deceptive intent without the required license under § 5.11 first having been obtained, and
4. The required fee (§ 1.17(h)).

The petition is denied since the requirements of 37 CFR 5.25 (3)(ii-iii) have not been met.

Specifically, the petition is denied for the following reasons;

1. There is no convincing evidence that the patent application was filed abroad through error and without deceptive intent. Sufficient evidence should include statements by those who had knowledge and made the actual decision to file abroad without first securing a foreign filing license. In the instant case, the statement(S) should be by the person or persons of Storz Endoscope GmbH. Further, the statements should reference not only the proscribed filing error but should also document what, if anything, is currently done to rectify the docketing of similar proscribed filings.
2. The circumstances surrounding discovery of the proscribed filing needs clarification. Specifically, to satisfy the diligence requirement, there needs to be more clarification on when and how the proscribed filings were discovered.

Accordingly, the provisions of 37 CFR 5.25 not having been fully met, the petition is denied, and in the absence of any response within 60 days of the mailing date of this letter, such denial will be made final and the final action under 35 U.S.C. 185 will be taken. Extensions of time may be had under 37 C.F.R. 1.136(a).



Ian J. Lobo
Patent Examiner
(703) 306-4161

PATENT
02931-P0023A WWW

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventors	Karl Storz <i>et al.</i>
U.S. Patent No. 6,042,593	Issue Date: March 28, 2000
Serial No. 09/077,180	Filed: July 16, 1998
Title of Patent:	Shaving Or Cutting Instrument

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**CORRESPONDENCE RESUBMITTING RESPONSE AND
TWO DECLARATIONS**

Pursuant to a conversation today with Examiner Ian J. Lobo, submitted herewith are the following documents originally submitted on April 11, 2005:

1. Response to Non-Final Decision Regarding Petition For Retroactive Foreign Filing License Pursuant to 37 C.F.R. 5.25;
2. Declaration of Simon Solingen In Support of Petition For Retroactive Foreign Filing License Under 37 C.F.R. 5.25; and

Facsimile Certificate: I hereby certify that this correspondence is today being sent via facsimile addressed to: Examiner Ian J. Lobo, facsimile number 571-273-6974.

May 16, 2005


Lisa A. Evensen

U.S. Patent No. 6,042,593
Correspondence Resubmitting Response and Two Declarations
Page 2

3. Declaration of Dr. Winfried Fugmann In Support of Petition For Retroactive Foreign Filing License Under 37 C.F.R. 5.25.

Sincerely,



Wesley W. Whitmyer, Jr.
wwwjr@ssjr.com

Case No. 02931-P0023A WWW/lae

Applicants: Karl Storz (deceased), *et al.*

SN: 09/077,180 Filed 1998/07/16 Group 3731
U.S. Patent No. 6,042,593 Issued: March 28, 2000
For: Shaving Or Cutting Instrument

Receipt is hereby acknowledged of Response To Non-Final Decision Regarding
Petition For Retroactive Foreign Filing License Pursuant To 37 C.F.R. 5.25,
Declaration Of Simon Solingen In Support Of Petition For Retroactive Foreign
Filing License Under 37 C.F.R. 5.25 and Declaration Of Dr. Winfried Fugmann In
Support Of Petition For Retroactive Foreign Filing License Under 37 C.F.R. 5.25.

Mailed April 11, 2005

Commissioner
for Patents

Case No. 02931-P0023A WWW/lae

Applicants: Karl Storz (deceased), *et al.*

SN: 09/077,180 Filed 1998/07/16 Group 3731
U.S. Patent No. 6,042,593 Issued: March 28, 2000
For: Shaving Or Cutting Instrument

Receipt is hereby acknowledged of Response To Non-Final Decision Regarding
Petition For Retroactive Foreign Filing License Pursuant To 37 C.F.R. 5.25,
Declaration Of Simon Solingen In Support Of Petition For Retroactive Foreign
Filing License Under 37 C.F.R. 5.25 and Declaration Of Dr. Winfried Fugmann In
Support Of Petition For Retroactive Foreign Filing License Under 37 C.F.R. 5.25.

Mailed April 11, 2005

Commissioner
for Patents

PATENT
02931-P0023A WWW

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventors	Karl Storz <i>et al.</i>
U.S. Patent No. 6,042,593	Issue Date: March 28, 2000
Serial No. 09/077,180	Filed: July 16, 1998
Title of Patent:	Shaving Or Cutting Instrument

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**RESPONSE TO NON-FINAL DECISION REGARDING PETITION FOR
RETROACTIVE FOREIGN FILING LICENSE PURSUANT TO 37 C.F.R. 5.25**

Dear Sir:

In response to the non-final decision of the Examiner mailed February 10, 2005, patentee, through its undersigned attorneys, is submitting herewith:

1. Declaration Of Simon Solingen In Support Of Petition For Retroactive Foreign Filing License Under 37 C.F.R. 5.25; and
2. Declaration Of Dr. Winfried Fugmann In Support Of Petition For Retroactive Foreign Filing License Under 37 C.F.R. 5.25.

These declarations are being submitted to further ensure that the requirements of 37 C.F.R. 5.25 are met. Together with Patentee's prior submissions in support of its petition, the accompanying declarations evidence that it was through error and without deceptive intent that the subject matter of the above-captioned

Mailing Certificate: I hereby certify that this correspondence is today being deposited with the U.S. Postal Service as *First Class Mail* in an envelope addressed to: Commissioner for Patents; P.O. Box 1450; Alexandria, VA 22313-1450.

April 11, 2005


Lisa A. Evensen

Page 2
U.S. Patent No. 6,042,593
Response to Non-Final Decision on
Petition for Retroactive Foreign Filing License

patent was foreign filed before issuance of a foreign filing license by the United States Patent and Trademark Office.

Patentee believes that all requirements for granting a retroactive foreign filing license to Patentee have been met. Patentee respectfully requests that its petition for retroactive foreign filing license be granted.

Respectfully submitted,



Wesley W. Whitmyer, Jr., Registration No. 33,558
Attorney for Applicant
ST.ONGE STEWARD JOHNSTON & REENS LLC
986 Bedford Street
Stamford, CT 06905-5619
203 324-6155

PATENT
02931-P0023A WWW

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventors	Karl Storz <i>et al.</i>
U.S. Patent No. 6,042,593	Issue Date: March 28, 2000
Title of Patent:	Shaving Or Cutting Instrument

**DECLARATION OF SIMON SOLINGEN IN SUPPORT OF PETITION
FOR RETROACTIVE FOREIGN FILING LICENSE UNDER 37 C.F.R. 5.25**

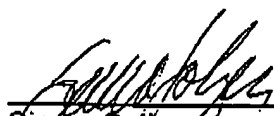
I, Simon Solingen, hereby declare and state as follows:

1. I am one of the inventors of the inventions of United States Patent No. 6,042,593 ("the '593 patent") and of the relevant German applications and PCT application that preceded the '593 patent. I make this declaration in support of the Petition For Retroactive Foreign Filing License Pursuant To 37 C.F.R. 5.25, which was submitted on August 26, 2004.
2. I presently reside in the United States and I resided in the United States when the application leading to the '593 patent was filed and when the relevant German and PCT applications were filed.
3. I did not know at the time of filing of any of the above applications that it was necessary either to file first an application in the United States on the subject inventions or to obtain a foreign filing license before filing an application outside of the United States.

Page 2
U.S. Patent No. 6,042,593
Declaration of Simon Solingen

I hereby declare that all statements made herein of my own knowledge are true, and that all statements made on information and belief are believed to be true; and further, that the statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

09 MARCH 2005
Date


Simon Solingen

PATENT
02931-P0023A WWW

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventors	Karl Storz <i>et al.</i>
U.S. Patent No. 6,042,593	Issue Date: March 28, 2000
Title of Patent:	Shaving Or Cutting Instrument

**DECLARATION OF DR. WINFRIED FUGMANN IN SUPPORT OF PETITION
FOR RETROACTIVE FOREIGN FILING LICENSE UNDER 37 C.F.R. 5.25**

I, Winfried Fugmann, hereby declare and state as follows:

1. I am the Head of the Patent Department at Karl Storz GmbH & Co. KG and have responsibility for patent matters at Storz Endoskop GmbH and its successor, Storz Endoskop Produktions GmbH. I make this declaration in support of the Petition For Retroactive Foreign Filing License Pursuant To 37 C.F.R. 5.25, which was submitted on August 26, 2004.

2. Storz Endoskop GmbH, the assignee of the patent in question, and its successor, Storz Endoskop Produktions GmbH, are part of the multinational Karl Storz group (hereinafter "Storz"), based in Germany, with facilities in various countries, including Germany, Switzerland and the United States.

Page 2
U.S. Patent No. 6,042,593
Declaration of Dr. Winfried Fugmann

3. In the present case, the three inventors of the subject matter to which the patent in question is directed were Karl Storz in Germany, who is now deceased; Pavel Novak in Switzerland, who is no longer affiliated with Storz; and Simon Solingen in the United States.

4. At the time of the proscribed filings, there was no in-house attorney with responsibility for patent matters at Storz.

5. To the best of my knowledge, all at Storz believed that the subject inventions had been made in Germany until recently, when counsel in the United States informed me that the inventions more likely were made in the United States than in Germany.

6. The present petition for retroactive foreign filing license was filed promptly after I learned about the proscribed facts.

7. The proscribed filings in the present case were made, to the best of my knowledge, through error and without deceptive intent because of the erroneous identification of Germany as the country where the inventions had been made.

8. It has been and is Storz's long-standing policy to obtain all necessary foreign filing licenses.

Page 3
U.S. Patent No. 6,042,593
Declaration of Dr. Winfried Fugmann

I hereby declare that all statements made herein of my own knowledge are true, and that all statements made on information and belief are believed to be true; and further, that the statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

April 8, 2005
Date

W. Fugmann
Dr. Winfried Fugmann

TOTAL P.05

***** -COMM. JOURNAL- ***** DATE MAY-16-2005 ***** TIME 15:08 *****

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May 16, 2005

DELIVER TO
 Examiner Ian J. Lobo

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FAX NUMBER
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FROM
 Wesley W. Whitmyer, Jr.

Re: Inventors: Karl Storz, et al.
 U.S. Patent No. 6,042,593
 Issue Date: March 28, 2000
 Serial No. 09/077,180
 Shaving Or Cutting Instrument
 SSJR File 02931-P0023A

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